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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,377	12/04/2003	Hayley Korn	47187/20	6211

38137 7590 07/31/2006

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EXAMINER

HAROLD, JEFFEREY F

ART UNIT

PAPER NUMBER

2614

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/728,377

Applicant(s)

KORN ET AL.

Examiner

Jefferey F. Harold

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. ***Claims 1, 2, 5, 14-17 and 20*** are rejected under 35 U.S.C. 102(e) as being anticipated by Veschi (United States Patent 6,122,366).

Regarding **claim 1**, Veschi discloses a telephone with environmentally influenced call indicator. In addition Veschi discloses an apparatus for disabling a telephone ringer comprising: a light sensing device operable to produce a signal indicative of a level of ambient light; and a controller operable to receive the signal and disable the telephone ringer when the signal indicates that the ambient light has reached a predetermined level, as disclosed at column 2, lines 12-51 and exhibited in figures 1 and 2.

Regarding **claim 2**, Veschi discloses everything claimed as applied above (see claim 1), in addition Veschi discloses wherein the controller is operable to disable the telephone ringer when the signal indicates that the ambient light has fallen below a predetermined threshold, as disclosed at column 2, lines 12-51 and exhibited in figures 1 and 2.

Regarding **claim 5**, Veschi discloses everything claimed as applied above (see claim 1), in addition Veschi discloses wherein the light sensing device and controller are integral with the telephone, as disclosed at column 2, lines 12-51 and exhibited in figures 1 and 2.

Regarding **claim 14**, Veschi discloses an apparatus for disabling a telephone ringer comprising: a light sensing device operable to produce a signal indicative of a predetermined level of ambient light; a controller operable to receive the signal and disable the telephone ringer when the signal indicates that the ambient light has reached the predetermined level; and a recording device operable to communicate with the controller and play back a recording to a calling party when the controller has disabled the telephone ringer, as disclosed at column 2, lines 12-51; column 3, line 65 through column 4, line 8 and exhibited in figures 1, 2, and 6.

Regarding **claim 15**, Veschi discloses everything claimed as applied above (see claim 14), in addition Veschi discloses wherein the controller is operable to enable and disable the recording device such that the recording device may play back a recording to a calling party only when the signal indicates that the ambient light has reached the predetermined level, as disclosed at column 2, lines 12-51; column 3, line 65 through column 4, line 8 and exhibited in figures 1, 2, and 6.

Regarding **claim 16**, Veschi discloses everything claimed as applied above (see claim 14), in addition Veschi discloses wherein the recording device is operable to receive and retain a message from the calling party, as disclosed at column 2, lines 12-51; column 3, line 65 through column 4, line 23 and exhibited in figures 1, 2, and 6.

Regarding **claim 17**, Veschi discloses everything claimed as applied above (see claim 14), in addition Veschi discloses wherein the controller is operable to disable the telephone ringer when the signal indicates that the ambient light has fallen below a predetermined threshold, as disclosed at column 2, lines 12-51; column 3, line 65 through column 4, line 23 and exhibited in figures 1, 2, and 6.

Regarding **claim 20**, Veschi discloses everything claimed as applied above (see claim 14), in addition Veschi discloses wherein the light sensing device and controller are integral with the telephone, as disclosed at column 2, lines 12-51; column 3, line 65 through column 4, line 23 and exhibited in figures 1, 2, and 6.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. ***Claim 3, 18, and 37*** are rejected under 35 U.S.C. 103(a) as being unpatentable over Veschi in view of well know prior art (MPEP 2144.03).

Regarding **claim 3**, Veschi disclose everything claimed, as applied above, (see claim 1), in addition Veschi discloses a photo sensor, however, Veschi fails to disclose the type of photo sensor. However, the examiner takes official notice of the fact that it

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was well known in the art to provide a photo sensor from the group of photovoltaic cell, a photo-transistor, and a photo-resistor.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Veschi by specifically providing a photo sensor from the group of photovoltaic cell, a photo-transistor, and a photo-resistor, for the purpose of measuring a light level and producing an electrical signal the magnitude of which corresponds to the measured light level.

Regarding **claim 18**, Veschi discloses everything claimed as applied above (see claim 14), in addition it is interpreted and thus rejected for the reasons set forth above in the rejection of claim 3.

Regarding **claim 37**, Veschi and Redd, the combination, disclose everything claimed as applied above (see claim 31), in addition it is interpreted and thus rejected for the reasons set forth above in the rejection of claim 3.

3. **Claims 4, 19 and 38** are rejected under 35 U.S.C. 103(a) as being unpatentable over Verschi in view of Cameron (United States Patent 5,131,030).

Regarding **claim 4**, Verschi discloses everything claimed as applied above (see claim 1), in addition Verschi discloses wherein the light sensing device and controller are integral with the telephone, however, Verschi fails to disclose wherein the light sensing device and controller are external to the telephone and the controller is operable to couple between a telephone line and an input connection of the telephone. However, the examiner maintains that it was well known in the art to provide wherein

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the light sensing device and controller are external to the telephone and the controller is operable to couple between a telephone line and an input connection of the telephone, as taught by Cameron.

In a similar field of endeavor Cameron discloses a light controlled telephone ringer. In addition, Cameron discloses wherein the light sensing device and controller are external to the telephone and the controller is operable to couple between a telephone line and an input connection of the telephone, as disclosed at column 5, line 16 through column 6, line 36 and exhibited in figure 3.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Verschi by specifically providing wherein the light sensing device and controller are external to the telephone and the controller is operable to couple between a telephone line and an input connection of the telephone, as taught by Cameron, for the purpose of allowing for portability and cost reduction.

Regarding **claim 19**, Veschi discloses everything claimed as applied above (see claim 14), in addition it is interpreted and thus rejected for the reasons set forth above in the rejection of claim 4.

Regarding **claim 38**, Veschi and Redd disclose everything claimed as applied above (see claim 31), in addition claim 38 is interpreted and thus rejected for the reasons set forth above in the rejection of claim 4.

4. **Claims 31-36 and 39** are rejected under 35 U.S.C. 103(a) as being unpatentable over Verschi in view of Redd, Jr. et al. (United States Patent 5,467,388), hereinafter referenced as Redd.

Regarding **claim 31**, Veschi discloses an apparatus for disabling a telephone ringer comprising: a light sensing device operable to produce a signal indicative of a level of ambient light; a recording device operable to play back a recording to a calling party, and a controller communicating with the light sensing device and the recording device, the controller being operable to receive the signal and both (i) to disable the telephone ringer, and (ii) enable the recording device such that the recording device may play back the recording to the calling party, when the signal indicates that the ambient light has reached a predetermined level, as disclosed at column 2, lines 12-51; column 3, line 65 through column 4, line 23 and exhibited in figures 1, 2, and 6, however, Veschi fails to disclose the recording prompting the calling party to provide indicia that the call is a priority call and the controller being operable to initiate an emergency sequence when the indicia indicates that the call is a priority call. However, the examiner maintains that it was well known in the art to provide the recording prompting the calling party to provide indicia that the call is a priority call and the controller being operable to initiate an emergency sequence when the indicia indicates that the call is a priority call, as taught by Redd.

In a similar field of endeavor Redd discloses a method and apparatus for selectively blocking incoming telephone calls. In addition, Redd discloses the recording prompting the calling party to provide indicia that the call is a priority call and the



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controller being operable to initiate an emergency sequence when the indicia indicates that the call is a priority call, as disclosed at column 6, line 58 through column 8, line 55 and exhibited in figure 1.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Veschi by specifically providing the recording prompting the calling party to provide indicia that the call is a priority call and the controller being operable to initiate an emergency sequence when the indicia indicates that the call is a priority call, as taught by Redd, for the purpose of ensuring emergency call are not blocked by the system.

Regarding **claim 32**, Veschi discloses everything claimed as applied above (see claim 31), however, Veschi fails to disclose wherein the emergency sequence includes enabling the telephone ringer irrespective of whether the signal indicates that the ambient light has reached the predetermined level. However, the examiner maintains that it was well known in the art to provide wherein the emergency sequence includes enabling the telephone ringer irrespective of whether the signal indicates that the ambient light has reached the predetermined level, as taught by Redd.

In addition, Redd discloses wherein the emergency sequence includes enabling the telephone ringer irrespective of whether the signal indicates that the ambient light has reached the predetermined level, as disclosed at column 6, line 58 through column 8, line 55 and exhibited in figure 1.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Veschi by specifically providing wherein the

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emergency sequence includes enabling the telephone ringer irrespective of whether the signal indicates that the ambient light has reached the predetermined level, as taught by Redd, for the purpose of ensuring emergency call are not blocked by the system.

Regarding **claim 33**, Veschi discloses everything claimed as applied above (see claim 31), however, Veschi fails to disclose an alert device in communication with the controller, the controller activating the alert device when the indicia indicates that the call is a priority call. However, the examiner maintains that it was well known in the art to provide an alert device in communication with the controller, the controller activating the alert device when the indicia indicates that the call is a priority call, as taught by Redd.

In addition, Redd discloses an alert device in communication with the controller, the controller activating the alert device when the indicia indicates that the call is a priority call, as disclosed at column 6, line 58 through column 8, line 55 and exhibited in figure 1.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Veschi by specifically providing an alert device in communication with the controller, the controller activating the alert device when the indicia indicates that the call is a priority call, as taught by Redd, for the purpose of ensuring emergency call are not blocked by the system.

Regarding **claim 34**, Veschi discloses everything claimed as applied above (see claim 31), however, Veschi fails to disclose wherein the recording prompts the calling party to press a telephone keypad button to indicate that the call is a priority call, the

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controller being operable to recognize the pressed telephone keypad button such that the emergency sequence is initiated. However, the examiner maintains that it was well known in the art to wherein the recording prompts the calling party to press a telephone keypad button to indicate that the call is a priority call, the controller being operable to recognize the pressed telephone keypad button such that the emergency sequence is initiated, as taught by Redd.

In addition, Redd discloses wherein the recording prompts the calling party to press a telephone keypad button to indicate that the call is a priority call, the controller being operable to recognize the pressed telephone keypad button such that the emergency sequence is initiated, as disclosed at column 6, line 58 through column 8, line 55 and exhibited in figure 1.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Veschi by specifically providing wherein the recording prompts the calling party to press a telephone keypad button to indicate that the call is a priority call, the controller being operable to recognize the pressed telephone keypad button such that the emergency sequence is initiated, as taught by Redd, for the purpose of ensuring emergency call are not blocked by the system.

Regarding **claim 35**, Veschi and Redd, the combination, discloses everything claimed as applied above (see claim 31) in addition, Veschi discloses wherein the recording device is operable to receive and retain a message from the calling party, as disclosed at column 2, lines 12-51; column 3, line 65 through column 4, line 23 and exhibited in figures 1, 2, and 6.

Regarding **claim 36**, Veschi and Redd, the combination, discloses everything claimed as applied above (see claim 31) in addition, Veschi discloses wherein the controller is operable to disable the telephone ringer and enable the recording device when the signal indicates that the ambient light has fallen below a predetermined threshold, as disclosed at column 2, lines 12-51; column 3, line 65 through column 4, line 23 and exhibited in figures 1, 2, and 6.

Regarding **claim 39**, Veschi and Redd, the combination, discloses everything claimed as applied above (see claim 31) in addition, Veschi discloses wherein the light sensing device and controller are integral with the telephone, as disclosed at column 2, lines 12-51; column 3, line 65 through column 4, line 23 and exhibited in figures 1, 2, and 6.

***Allowable Subject Matter***

5. ***Claims 6-13, 21-30 and claims 40-51*** are allowed.

6. The following is an examiner's statement of reasons for allowance:

Regarding **claim 6**, the prior art of record discloses devices for disabling a telephone ringer based on ambient light or a timing device. However, the prior art of record fails to disclose or fairly suggest a device that comprises both light sensing and timing circuitry where indication from either circuitry is used to disable the telephone ringer.

Regarding **claim 21**, the prior art of record discloses devices for disabling a telephone ringer based on ambient light or a timing device and a recording device to

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play a recording to the calling party prompting the calling party. However, the prior art of record fails to disclose or fairly suggest a device that comprises both light sensing and timing circuitry where indication from either circuitry is used to disable the telephone ringer.

Regarding **claim 40**, the prior art of record discloses devices for disabling a telephone ringer based on ambient light or a timing device and a recording device to prompting the calling party to enter a code to override the ringer disable. However, the prior art of record fails to disclose or fairly suggest a device that comprises both light sensing and timing circuitry where indication from either circuitry is used to disable the telephone ringer.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

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F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. **Claims 1-51** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 31-53 and 56-49 of U.S. Patent No.

6,917,680. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application is also drawn to the inventive concept of using timer circuitry, lighting circuitry or both to disable the telephone ringer.

#### ***Citation of Pertinent Art***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Klee (United States Patent 4,384,171), discloses an automatic telephone silencer.

Wanner (United States Patent 5,812,648), discloses a telephone ringer control device.

Ellison (United States Patent 5,317,632), discloses a timed telephone silencer.

Groff (United States Patent 4,405,839), discloses a timed telephone ring silencer.

Hokao et al. (United States Patent 6,044,279), discloses a portable apparatus with adjustable-volume of ringing tone.

**Conclusion**

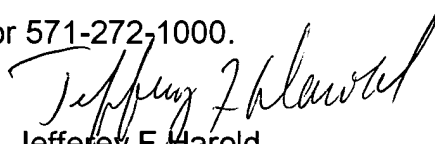
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jefferey F. Harold whose telephone number is 571-272-7519. The examiner can normally be reached on Monday - Friday 9 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wing F. Chan can be reached on 571-272-7493. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JFH  
July 25, 2006



Jefferey F. Harold  
Primary Examiner  
Art Unit 2614